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EXAMINER

VAN BRAMER, JOHN W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/747,950 | Applicant(s) ZORN, RICHARD C. | |
| | Examiner John Van Bramer | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on January 10, 2006 has been considered and is effective to overcome the DeBruin-Ashton (6,014,629) and Manley et al (5,186,443) references. The amendment did not add, delete or amend any claims. The currently pending claims considered below remain Claims 1 – 11.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "prior to step (b)" and "to be the subject of steps (b) to (c)" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim. Since dependent claims can contain multiple steps there is no antecedent basis for the steps as claimed. The minimum required change to correct this issue would be to change these statements to be "said step (b)" and "to be the subject of said steps (b) to (c)". The Examiner would prefer that the correction eliminate the reference to previous steps and distinctly state the step in the claim body.

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Additionally, phrase "from those subscribers to be the subject of steps (b) to (c)" appears to provide no additional structure to the claim. The Examiner has interpreted the claim to mean that the list of names is sorted into two groups, one containing subscribers that have the financial product or service and one containing subscribers that do not have the financial product or service.

Claim 11 recites the limitation "proceeding to step (h)" in line 11. There is insufficient antecedent basis for this limitation in the claim. Since dependent claims can contain multiple steps there is no antecedent basis for the steps as claimed. The minimum required change to correct this issue would be to change this statement to read, "proceeding to said step (h)". The Examiner would prefer that the correction eliminate the reference to previous steps and distinctly state the step in the claim body.

Additionally, Claim 11 recites the limitation "includes personalized information unique to the subscriber to whom the printed second brochure version is addressed". The examiner has interpreted this to mean "includes personalized information unique to the subscriber to whom the printed third brochure version is addressed", since the claim as originally stated would indicate the applicant is sending personalized information about the subscribers who currently have the financial product or service to the subscribers that did not meet the qualifying criteria.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 3, 5 – 7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Geerlings (U.S. Patent Number: 5,956,693).

Claim 1: Geerlings discloses a method comprising the steps of:

- a. Creating a first brochure version template and a second brochure version template, wherein each template has a variable print field. (Col 4, line 58 through Col 5, line 31; and Col 14, lines 40 – 46)
- b. Accessing a subscriber list of subscribers to the periodical. (Col 4, line 58 through Col 5, line 31)
- c. Establishing a sorting criteria for sorting the subscriber list into sub-lists. (Col 10, lines 37 – 58)
- d. Generating a first sub-list of subscribers and a second sub-list of subscribers based on the sorting criteria. (Col 12, line 65 through Col 13, line 12)
- e. Printing a first brochure version for each subscriber in said first sub-list by calling up the first brochure version template and subscriber information

corresponding to the variable print field, and printing the brochure using print information from the template and subscriber information, wherein each printed first brochure version includes personalized information unique to a subscriber included in the first sub-list and to whom the printed first brochure version is addressed. (Col 14, lines 18 – 47)

- f. Printing a second brochure version for each subscriber in said second sub-list by calling up the second brochure version template and subscriber information corresponding to the variable print field, and printing the brochure using print information from the template and subscriber information, wherein each printed second brochure version includes personalized information unique to a subscriber included in the second sub-list and to whom the printed first brochure version is addressed. (Col 14, lines 18 – 47)
- g. Attaching the first and second printed brochure versions to a respective copy of a periodical. (Col 14, lines 18 – 47)
- h. Sending each of the printed brochure versions with attached periodical to the subscriber to which the brochure is addressed. (Col 14, lines 18 – 47)

Claim 2: Geerlings discloses a method as in claim 1 wherein the sorting criteria relates to a characteristic of subscribers. (Col 4, line 58 through Col 5, line 31)

Claim 3: Geerlings discloses a method as in claim 2 wherein the sorting criteria relates to subscriber fiscal credit. (Col 16, lines 13 – 34)

Claim 5: Geerlings discloses a method for targeting promotions to individual subscribers of a periodical comprising the steps of:

- a. Selecting at least one sorting criteria to classify each of the subscribers. (Col 4, line 58 through Col 5, line 31)
- b. Accessing a first database having information regarding subscribers, and accessing at least a second database having information on individuals that is related to the sorting criteria. (Col 3, lines 41 – 59)
- c. Sorting subscribers into a first sub-group or a second sub-group by applying the sorting criteria to the first database and the at least second database. (Col 4, line 58 through Col 5, line 31; and Col 10, lines 37 – 58)
- d. Printing a first brochure version for each of the subscribers listed in said first sub-group, wherein each printed first brochure version includes information targeted to subscribers in the first sub-group and personalized information unique to the subscriber to whom the printed first brochure version is addressed. (Col 14, lines 18 – 47)
- e. Printing a second brochure version for each of the subscribers listed in said first sub-group, wherein each printed second brochure version includes information targeted to subscribers in the second sub-group and personalized information unique to the subscriber to whom the printed second brochure version is addressed. (Col 14, lines 18 – 47)
- f. Attaching the first and second printed brochure versions to respective copies of the periodical. (Col 14, lines 18 – 47)
- g. Sending each of the printed brochure versions with the attached periodical to the subscriber to which the brochure is addressed. (Col 14, lines 18 – 47)

Claim 6: Geerlings discloses a method as in claim 5 wherein the sorting criteria relates to a characteristic of the subscribers. (Col 4, line 58 through Col 5, line 31)

Claim 7: Geerlings discloses a method as in claim 7 wherein the sorting criteria relates to subscriber fiscal credit. (Col 16, lines 13 – 34)

Claim 9: Geerlings discloses a method for targeting a financial product or service promotion to subscribers of a periodical comprising the steps of:

- a. Selecting at least one qualifying criteria to sort the subscribers, where the qualifying criteria relates to credit history. (Col 16, lines 13 – 34)
- b. For each subscriber, accessing a database of credit histories and determining whether the credit history of the subscriber satisfies the qualifying criteria. (Col 16, lines 13 – 34)
- c. Assigning subscribers that satisfy the qualifying criteria to a first group and assigning other subscribers to a second group. (Col 16, lines 13 – 34)
- d. Printing a first brochure version for each subscriber in said first group, wherein each printed first brochure version includes a pre-approved activation coupon for the product or service, and the coupon includes personalized information unique to the subscriber to whom the printed first brochure version is addressed. (Col 16, lines 13 – 34 and Col 14, lines 18 – 47)
- e. Printing a second brochure version for each subscriber listed in said second group, wherein each printed second brochure version includes an application for the financial product or service, which application has not been pre-

approved, and said second brochure version includes personalized information unique to the subscriber to whom the printed second brochure version is addressed. (Col 16, lines 13 – 34 and Col 14, lines 18 – 47)

- f. Attaching the first and second printed brochure versions to respective copies of the periodical. (Col 14, lines 18 – 47)
- g. Sending each of the printed brochure versions with the attached periodical to the subscriber to whom the brochure is addressed. (Col 14, lines 18 – 47)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 8, 10 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Geerlings (U.S. Patent Number: 5,956,693).

Claims 4 and 8: Geerlings discloses a method as in claim 1 and Claim 5 respectively, including any combination of a specific letter, form letter, preprinted brochure, catalogues, attachments, enclosures, E-mail files, or other documents (Col 4, line 58 through Col 5, line 31). It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the method as taught in Geerlings to incorporate at least 25% of the first and second printed brochure

versions with substantive editorial or public service information or both. Additionally, the Applicant has not disclosed that meeting the 25% threshold provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the present web design and presentation of the information as taught by Geerlings, it appears to be an arbitrary design consideration which fails to patentably distinguish over Geerlings. Therefore, it would have been an obvious matter of design choice to modify Geerlings to obtain the invention as specified in the claim(s).

Claim 10: Geerlings discloses a method as in claim 9 and incorporates filter groups and segment tables to allow for enhanced searching and sorting (Col 7, line 59 through Col 8, line 28). While Geerlings is silent with regard to sorting subscribers who currently have the financial product or service, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the invention would be able to be utilized, without any modification, in such a fashion. One would have been motivated to sort based on current subscribers and non-subscribers to ensure that the material being sent to these groups was specifically tailored. This would result in a better response ratio to the information supplied and increase the effectiveness of the campaign.

Claim 11: Geerlings discloses a method as in claim 10 further comprising the steps of:

- a. Printing a third brochure version for each subscriber currently having the financial product or service, wherein each printed third brochure version includes coupons to promote the use of the product or service, and said third brochure version includes personalized information unique to the subscriber to whom the printed second brochure version is addressed (Col 14, lines 18 – 47)
- b. Attaching the third brochure versions to respective copies of the periodical, and proceeding to step (h). (Col 14, lines 18 – 47)

Response to Arguments

7. Applicant's arguments, see lines 12 - 23, filed January 10, 2006, with respect to the rejection(s) of claim(s) 1 - 11 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Geerlings (U.S. Patent Number: 5,956,693).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
Schumacher (U.S. Patent Number: 5,058,030), which discloses mailing multiple documents in the same envelope.

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Bucci (U.S. Patent Number: 5,655,089), which discloses mail consolidation and transmission

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jvb



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